UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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VISA INC. and VISA U.S.A. INC.
APPLE INC.,

Petitioners,

v.

UNIVERSAL SECURE REGISTRY LLC,

Patent Owner

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Case IPR2018-01350[1]

U.S. Patent No. 8,856,539

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PATENT OWNER'S REPLY IN SUPPORT OF ITS MOTION TO AMEND

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[1]   Apple Inc., which filed a petition in IPR2019-00727, has been joined as a party
to this proceeding.

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PATENT OWNER'S LIST OF EXHIBITS

Ex. 2001	Declaration of Dr. Markus Jakobsson in Support of Patent Owner's Preliminary Response.
Ex. 2002	Curriculum Vitae of Dr. Markus Jakobsson.
Ex. 2003	Terminal Disclaimer Dated August 17, 2018.
Ex. 2004	Declaration of Dr. Markus Jakobsson in Support of Patent Owner's Response.
Ex. 2005	Transcript of Dr. J. Douglas Tygar Deposition Dated April 19, 2019.
Ex. 2006	N. Asokan, et. al, The State of the Art in Electronic Payment Systems, IEEE Computer, Vol. 30, No. 9, pp. 28-35 (IEEE Computer Society Press, Sept. 1997).
Ex. 2007	M. Baddeley, Using E-Cash in the New Economy: An Economic Analysis of Micropayment Systems, J. Electronic Commerce Research, Vol. 5, No. 4, pp. 239-253 (Nov. 2004).
Ex. 2008	U.S. Application No. 11/768,729.
Ex. 2009	U.S. Application No. 09/710,703.
Ex. 2010	Declaration of Dr. Markus Jakobsson in Support of Motion to Amend.
Ex. 2011	Declaration of Dr. Markus Jakobsson in Support of Patent Owner's Reply to Opposition of Conditional Motion to Amend
Ex. 2012	U.S. District Court for Delaware Report and Recommendation.

Universal Secure Registry LLC ("Patent Owner") submits this Reply in support of its Conditional Motion to Amend, Paper 13 ("MTA"), and in response to Petitioner's Opposition to the MTA, Paper 17 ("Opp.").

I. MTA PRESENTS A REASONABLE NUMBER OF CLAIMS

Title 35 U.S.C. § 316(d) allows PO to file one motion to amend having a reasonable number of substitute claims per instituted IPR proceeding. Here, PO's MTA submits one substitute claim for each of challenged claims 1-4, 9, 16, 21-25, 31, 37, and 38, which is presumptively a reasonable number of substitute claims. *See* 37 C.F.R. § 42.121(a)(3).

Petitioner ("VISA") complains that if *other* substitute claims for the '539 patent are granted in *another* currently pending IPR proceeding (IPR2018-00812), Petitioner will have had no opportunity to be heard. *See* Opp. at 2. VISA has no right to be heard in a proceeding before this Board for which it is not a petitioner. Petitioner also wrongly implies that the present MTA is defective because it does not allegedly "explain whether the requested amendments are patentably distinct from those sought in the Apple CMTA." *See id.* The Rules preclude a patent owner from obtaining in any patent a claim that is not patentably distinct from a "finally refused or canceled claim." 37 C.F.R. § 42.73(d)(3)(i). But a claim is not *finally* refused and estoppel does not apply according to § 42.73(d)(3)(i) until the claims at

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